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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,568	06/19/2006	Wataru Hattori	19931	8978
23389 7590 11/10/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PALADINI ALBERT WILLIAM				
ART UNIT		PAPER NUMBER		
2836				
MAIL DATE		DELIVERY MODE		
11/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/583,568

**Applicant(s)**

HATTORI ET AL.

**Examiner**

ALBERT W. PALADINI

**Art Unit**

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date 6/19/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "artificial nullification" is used in line 17 on page 2 and in line 14 on page 3. There is no definition of this phrase in the specification. The understanding of this is relevant since "nullification" is used in claim 1. Also, in line 18 on page 2, the word "in" should be replaced with --to--, so that the phrase will read "negligence of this processing may fail to safely protect personal information".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

Lines 4-5 recite 'wherein said nullification unit includes a time switch isolating said circuit". The claim does not recite the "element" from which the circuit is isolated.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (6,933,848).

This rejection is made to the extent that the claims were understood. Since the claims are incomplete, it was necessary to speculate about the specific operation of some elements.

Figure 1 of Stewart depicts ID tags 108 communicating with RFID system 100. Since ID system 100 includes antenna 102, it is inherent that tags 108 include an antenna. With respect to the limitation isolating said circuit when a predetermined time limit for operation has reached after the start of use of the tag, in (C5, L9-18) Stewart refers to figure 2 and describes the decision to disable the tag so that it is not possible to read some or all of the information on the tag. Stewart does not explicitly describe isolating a circuit. As demonstrated in paragraph 4, this limitation is not understood. But, the function of disabling the tag described by Stewart may be performed by isolating or disconnecting a circuit because Stewart states in his abstract "The tag

disable the data by erasing the data, disabling the data, auto-destructing, or performing any operation that makes the data unreadable.” It is inherent that disconnecting or isolation the circuit would make the data unreadable.

***Relevant Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ward (6,046,676) discloses a tag for use for identifying and communicating with an electronic device which has the capability of isolating blocks of memory from improper access depending on the identity of the person making the inquiry or any other criteria determined to be harmful.

Pan (7,129,844) discloses remote communication devices consisting of processing circuitry, a configurable portion, and an antenna. The methodology depicted in the flowchart in figure 6 entails decision steps S14 and S18, and the antenna and processing circuitry of the remote communication device may be electrically isolated depending upon the preset conditions.

Clifford (7,132,947) discloses a system for operation of a data reader, which includes a deactivation unit for deactivating an electronic security tag. The deactivation unit is armed only after a successful read of the ID tag, and only for a limited time period after the successful read.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Albert W. Paladini whose telephone number is 571-272-3748. The

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examiner can normally be reached from 7:00 AM to 3 PM on Monday, Tuesday, Thursday or Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Elms can be reached on 571-272-1869.

/Albert W Paladini/

Primary Examiner, Art Unit 2836

October 30, 2008